

Sub D9
C1
End
38. (New) A toner supply container according to Claim 37, wherein said capping member is provided with a hole fitted by a shaft of said engaging member for sliding relative to the shaft, and when said opening is opened to permit toner discharge therethrough, the hole is fitted around the shaft. isn't it always?

Sub E1
Ant
39. (New) A toner supply container according to Claim 37 or 38, wherein said engaging portion is provided with a feeding portion for feeding the toner in said main body toward said opening.

REMARKS

Summary

In response to the double patenting rejection and the request to state the prior inventor of allegedly conflicting subject matter, Claims 1 and 27-36 have been canceled without prejudice and new independent Claim 37 has been added, which does not relate to the same invention as the claims of the '453 patent. Therefore, should the prior-inventor request and double-patenting rejection be withdrawn?

Status of the claims

Claims 37-39 are pending. Claims 1 and 27-36 have been canceled without prejudice. Claims 37-39 have been added. Claim 37 is independent.

Requested action

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding objections and rejections in view of the foregoing amendments and the following remarks.

Request to state prior inventor

The Examiner holds that Claims 1 and 27-36 are directed to the same invention as Claims 1-47 of U.S. Patent No. 6,128,453 and therefore, requires Applicants to state which entity is the prior inventor of the conflicting subject matter so that the Examiner can determine the applicability of 35 U.S.C. § 102(f) and (g) against the claims.

In response, while not conceding the propriety of the requirement, Applicants have canceled Claims 1 and 27-36, thereby rendering the request moot. In addition, Applicants submit that new independent Claim 37 is not directed to the same invention as Claims 1-47 of the '453 patent, so that such a request with respect to Claim 37 would be inappropriate.

Rejection

Claims 1 and 27-36 are rejected under 35 U.S.C. § 101 as claiming the same invention as Claims 1-47 of U.S. Patent No. 6,128,453.

Response to rejection

In response, while not conceding the propriety of the rejection, Claims 1 and 27-36 have been canceled without prejudice in favor of new Claims 37-39. Applicants submit that new Claims 37-39 are allowable over this patent for the following reasons.

Independent Claim 37 relates to a toner supply container detachably mountable to an image forming apparatus, comprising a main body for accommodating toner, an opening, provided in the main body, for permitting discharge of the toner, a capping member for capping the opening, and an engaging member slidably movable relative to the capping member to open and close the opening by relative movement of the capping member relative to the main body. When the opening is opened to permit toner discharge therethrough, an engagement between the capping member and the engaging member is maintained.

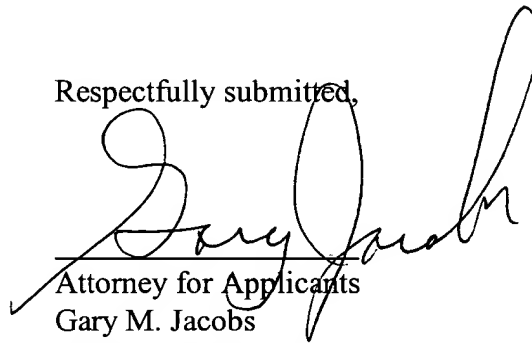
In contrast, none of the claims of the '453 patent relates to a container in which when the opening is opened to permit toner discharge therethrough, an engagement between the capping member and the engaging member is maintained, as recited by Claim 37. For this reason, Claim 37 is allowable over the claims of the '453 patent.

The dependent claims are allowable for the reasons given with respect to the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

In view of the above amendments and remarks, the claims are now in allowable form. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicants
Gary M. Jacobs
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile No.: (212) 218-2200

GMJ/lmj

DC_MAIN 87538v1